DOCKET NO.: VTN5003 PATENT
Application No.: 10/692,088
Office Action Summary Dated: October 23, 2003

REMARKS/ARGUMENTS

Claims 1-19 are pending in this application. Claims 1-19 are rejected.

No new matter is entered by any of these amendments.

I. Rejections under 35 U.S.C. 112

Claims 1-19 have been rejected under 35 U.S.C. 112, first paragraph as not being enabling as claimed. The Applicants respectfully traverse this rejection, since the Applicant's assert that a person skilled in the art would be able to ascertain if they infringed claim 1 by measuring a degree of swelling caused by a first liquid and shrinking caused by a second liquid without undue experimentation.

However, in order to expedite allowance of the pending claims, the Applicants have amended independent claim 1 according the to Examiner's comments to limit the presently claimed invention to liquids which include at least one of: a saline solution, an organic solvent, deionized water and buffered aqueous solutions. Applicant's respectfully retain the right to reclaim similar subject matter in subsequent prosecution.

Accordingly, Applicants respectfully request that this rejection under 35 U.S.C. 112 be withdrawn for the pending claims.

Although the Examiner has not specifically rejected claims related to the use of etafilcon A, the Examiner has expressed some concern as to how it is used in the Specification. The Applicants respectfully submit that to the best of their knowledge, etafilcon A is not a trademarked term, either registered or through common law usage, but a USAN name (United States Adopted Names). The purpose of USAN is to serve the health professions in the United States by selecting simple, informative, and unique nonproprietary names for drugs by establishing logical nomenclature classifications based on pharmacological and/or chemical relationships. (taken from the http://www.ama-assn.org/ website, emphasis added). Accordingly, the Applicants have not at this time amended the Specification, but remain open to presenting etafilcon A in whichever manner is most appropriate.

The Examiner has additionally rejected claims 1-19 under the second paragraph of 35 U.S.C. 112 as being indefinite because the Examiner has contended that it is unclear what is

considered functional size of a contact lens. The Applicants respectfully point out paragraph 0014 lines6-7 of the specification, where functional size is defined as the size of the lens, when the lens is sold to the end-user. Although different lenses may be produced in different sizes, the nature of a contact lens as a medical device requires that the lens have a specific size clearly ascertainable, in order to be used. The Applicants therefore respectfully contend that functional size of a particular lens is readily ascertainable to a person attempting to determine whether they are practicing the claimed invention.

II. Rejections under 35 U.S.C. 102

Claims 1-7, 9, 11-13 and 18 stand rejected under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Pat. No. 3,829,329 to O.Driscoll. ("'329 patent"). Applicants traverse the rejection because the '329 patent fails to disclose every element of the claimed subject matter.

The standard for anticipation under 35 U.S.C. § 102 is one of strict identity. An anticipation rejection requires that each limitation of a claim be found in a single reference, *Atlas Powder Co. v. E.I. DuPont de Nemours & Co.*, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984).

The '329 patent does not satisfy this standard. For example, the '329 patent fails to teach Applicants' method of swelling a contact lens to provide a lens that is 5% of larger than its functional size, as claimed in the currently amended claims. In addition, the '329 patent does not teach contacting a lens with a liquid comprising at least one of: a saline solution, an organic solvent, deionized water and buffered aqueous solutions in order to cause such swelling, as also claimed in the currently pending claims. Accordingly, because the '329 patent fails to disclose every element of the claimed molds, Applicants respectfully request that these rejections under 35 U.S.C. 102(b) be withdrawn.

Claims 1-3, 7 and 9-16 stand rejected under 35 U.S.C. 102(b) as allegedly being anticipated by WO01/45868A1 to Ayyagari. ("'868 patent"). Applicants traverse the rejection because the '868 patent fails to disclose every claim element. For example, the '868 patent also fails to teach Applicants' method of swelling a contact lens to provide a lens that is 5% of larger than its functional size, as claimed in the currently amended claims. Ayyagari actually teaches against significant swelling, since significant swelling can cause cracks in surface coatings on the contact lens. In addition, the '868 patent does not teach contacting a

lens with a liquid comprising at least one of: a saline solution, an organic solvent, deionized water and buffered aqueous solutions in order to cause such swelling, as also claimed in the currently pending claims. Because the '868 patent fails to disclose every element of the claimed molds, Applicants respectfully request that these rejections under 35 U.S.C. 102(b) be withdrawn Accordingly, Applicants respectfully request that these rejections under 35 U.S.C. 102(e) be withdrawn and the Examiner pass claims 1-3, 7 and 9-16 on to allowance.

III. Rejections under 35 U.S.C. 103

Claims 8 and 10 stand rejected under 35 U.S.C 103(a) as allegedly being unpatentable over the '329 patent; claims 8 and 17 stand rejected under 35 U.S.C 103(a) as allegedly being unpatentable over the '868 patent; and claims 18-19 stand rejected under 35 U.S.C 103(a) as allegedly being unpatentable over the '868 patent, in view of Qui et al (2004/018295).

A *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). For the reasons set forth above, the Applicants respectfully traverse these rejections, since the cited art does not describe or suggest all of the claimed limitations in the currently pending claims. Specifically, the cited art does not describe or suggest swelling a contact lens to a size that is 5% or larger than the functional size of the lens through contact with a first liquid and then shrinking the lens back to within 5% of its functional size by contact with a second liquid. Even more specifically, the cited art does not describe or suggest the required swelling and shrinking through contact with at least one of: a saline solution, an organic solvent, deionized water and buffered aqueous solutions.

Accordingly, the Applicants respectfully request that the Examiner allow the currently pending claims as amended.

IV. Conclusions

Applicants request the Examiner to:

(1) enter the amendments to claim 1;

(2) reconsider and withdraw the standing rejections of the claims; and

(3) pass claims 1-19 to allowance.

If the Examiner is of a contrary view, the Examiner is requested to contact the

undersigned attorney at (904) 443-3731.

Respectfully submitted,

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